

REMARKS/ARGUMENTS

Claims 1, 3 to 5, 7 to 10, 12 to 16, 19, 20, 23 and 26 to 34 remain in this application. Claims 2, 6, 11, 17, 18, 21, 22, 24 and 25 have been cancelled, without prejudice, to presenting in a continuing application. Claims 26 to 34 have been added.

Claim 26 is of a scope similar to claim 1, as amended in the Response filed April 23, 2004. Claims 27 to 34 are supported by original claims 11, 7, 8, 10, 12, 16, 19 and 20, respectively.

Claims 1 and 15 have been amended to base the amount of the material capable of migration on the binder and not on the total composition. Support for these amendments is found in original claims 11 and 15 and paragraphs [0002], [0003] and [0014].

The claim dependency of claims 13 to 15 and 23 have been changed.

For the convenience of the Examiner, the arguments present in the Amendment filed on February 22, 2005 (the “prior Amendment”), have been repeated below. Additional argument, directed to new claims 26 to 34, is also presented.

The Examiner has noted that a certified copy of the German priority application has not been filed and that the declaration is defective. Applicants are obtaining the certified copy and will submit it in due course. A Supplemental Application Data Sheet, which corrects the defective declaration, was enclosed with the prior Amendment.

Claim 1 has been amended to include the limitations of original claims 6, 11, 17 and 18. Claim 5 has been amended to return it to its original dependent form. Claim 9 has been rewritten in independent form.

Claims 1, 3 to 5, 7 to 10, 12, 14 and 15 have been rejected as being anticipated by Kupits US Patent No. 3,129,194 (Kupits). Since claim 1 has been amended to include the limitations of claims 17 and 18, claim 1 is no longer anticipated by Kupits.

Claims 17 and 18 were rejected as being obvious over Kupits in view of Dees et al. US Patent No. 4,816,319 (Dees). The examiner has taken the position that Dees teaches it is old and well-known in the art to have a PVC floor covering having a profile with elevations and recesses for the purpose of producing a resilient floor covering with increased wear and slip resistance, and therefore it would be obvious to modify Kupits to have a profile with elevations and recesses as suggested by Dees.

Further, the Examiner states, in the carryover paragraph on pages 5 and 6 of the Office Action, that “it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the profile of elevation and recesses in Dees et al. to where the average spacing between profile peaks in the centerline is more than about 200 μm and less than about 1000 μm and the difference in height between the elevations and the recesses is from about 20 μm to about 200 μm , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in the absence of showing unexpected results. *MPEP 2144.05(II).*”

However, since the purpose of forming the elevations and recesses in Dees (for its decorative lenticular effect, and wear and slip resistance) is different than the purpose of the presently claimed elevations and recesses (to improve soiling behavior in combination with the substance capable of migration), optimizing the elevations and recesses of Dees would not necessarily yield the presently claimed ranges of spacing and

height. In fact, there is no teaching or suggestion in Dees regarding spacing between the peaks. Therefore, there can be no motivation to optimize an undisclosed characteristic.

As held by the Court of Appeals for the Federal Circuit, in *In re Fritch*, 972 F2d 1260, 1266, 23 USPQ 2d 1780 (1992):

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” [FN 13] Although couched in terms of combining teaching found in the prior art, the same inquiry must be carried out in the context of a purported obvious ‘modification’ of the prior art. ...

FN 13. *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir. 1984)”

(Emphasis in original.) Since there is no teaching or suggestion of any criticality of peak spacing, there is no suggestion to modify or optimize such peak spacing. Consequently, there is no *prima facie* obviousness rejection of claims 17 and 18 over the combination of Kupits and Dees. Therefore, amended claim 1 and claims 7, 8, 10, 12, 16 and 19 and 20, dependent thereon are allowable.

Claim 9 requires the substance capable of migration to comprise at least two wax-like substances having different melting points. The Examiner has rejected claim 9 as being anticipated by Kupits. The Examiner takes the position that Kupits teaches “the wax-like substance comprises a plurality of wax-like substances having different melting points,” citing column 5, line 44, to column 6, line 10. The Examiner is in error. At column 5, lines 38 to 47, Kupits states:

“It is essential in carrying out the method of producing surface coverings in accordance with the invention that the composition used in making the granules contain a small amount of a release additive. Release additives in accordance with the invention are waxy substances which have a softening point of below 330° F. are satisfactory when compositions

comprising the preferred resinous binders are utilized in accordance with the invention."

(Emphasis supplied.) The specification continues by disclosing acceptable release additives. Therefore, while numerous different release additives are listed, there is no suggestion of using two of the release additives simultaneously, particularly two release additives having different melting points. If the Examiner disagrees, she is respectfully requested to point out specifically where in Kupits there is such a suggestion. Absent such a suggestion, independent claim 9 is allowable over Kupits.

Again, claim 26 is of a scope similar to claim 1, as amended in the Response filed April 23, 2004, which was rejected as being anticipated by Kupits. Claim 26 requires the amount of the substance capable of migration to be in excess of its compatibility in the composition. While the release additive of Kupits is the same type of material as the present substance capable of migration and amount of the release additive specified at column 6, lines 12 to 14, of Kupits overlaps the amount specified in present claim 27, the release additive of Kupits is not in excess of its compatibility in the final floor covering.

While the release additive of Kupits may be in excess of its compatibility in the unfused sheet material before it contacts the hot platen, some of the release additive is released in the hot platen. This is what prevents the unfused sheet of Kupits from sticking to the hot platen, which is the invention of Kupits. See column 2, line 48, to column 3, line 6.

Further, when the sheet, which has been consolidated by the hot platen, is fused into the final product, the remaining release additive is absorbed into the primary binder or resin. Therefore, in the final floor covering product of Kupits, the amount of the release additive is not in excess of its compatibility in the floor covering composition.

See column 6, lines 30 to 36, of Kupits where he warns that

"The principal binder and addition agents are then added to the mass of plasticizers, fused processing binder, pigments, fillers, stabilizers and release additive. This addition must be conducted so as not to increase the temperature of the mixture above about 120° F. This is necessary in order that no fusion or solvation of the principal resin and no absorption of the release agent will occur."

And at column 8, lines 48 to 54, Kupits continues by stating:

"It is important that the hot platen be maintained at a high enough temperature to effect flow and consolidation of the plastic composition but not sufficiently hot to effect complete fusion and solvation of the principal binder. If fusion should occur in the press, the release additive becomes absorbed in the composition and satisfactory release does not take place."

Then at column 8, line 65, to column 9, line 1, he states:

After the pressing operation, the sheet passes continuously through a fusing oven. ... In the fusion oven the temperature of the composition must reach the fusion temperature at which the principal binder becomes solvated by the plasticizers."

And at which point the release additive is absorbed into the principal binder. Also see Example 1 of Kupits (column 9, line 21, to column 10, line 32, wherein the principal binder is mixed at a temperature of less than 120° F, the unfused sheet is pressed in the hot platen, then the sheet is fused at which point the release agent is absorbed into the principal binder, and then the final floor covering is formed.

Present claim 26 is directed to a floor covering with a substance capable of migration in excess of its compatibility and not an intermediate unfused sheet. Again while the release agent in the unfused sheet of Kupits may be in excess of its compatibility, the release agent is absorbed into the principal binder of the fused final floor covering. Therefore, the amount of release agent in the floor covering of Kupits is less than its compatibility and the limitation of present claim 26 is not disclosed, taught or

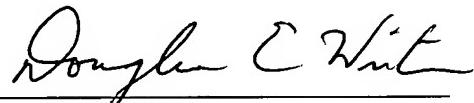
suggested by Kupits, and claim 26 and the claims dependent thereon are allowable over Kupits.

Kupits does not anticipate the present claims nor make them obvious. Therefore, since all of the rejections have been met, Attorney for Applicants submits that the present claims are in a condition for allowance. Therefore, early consideration and allowance are respectfully requested.

Respectfully submitted,

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Date



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